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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,846	01/25/2002	Calvin Roskelley	SMAR-020	1574
24353	7590	01/26/2005	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			HABTE, KAH SAY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/057,846

Applicant(s)

ROSHELLEY ET AL.

Examiner

Kahsay Habte, Ph. D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see memo.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-15, 17, 20, 40-44, 46 and 51-54.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **Advisory Action**

1. The amendment filed 1/13/2005 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance and will not be entered because:

In claim 1 (page 3), the proviso "and provided however if X is saturated alkyl chain of 12...with N<sup>1</sup>" lacks descriptive support in the specification. The concept linking the definition of X to Y and R<sub>1</sub> and R<sub>2</sub> was never present originally. Applicants did not indicate descriptive support for said proviso nor did they give reasons why the proviso is added in claim 1.

Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Rejected claim(s): 1-15, 17, 20, 40-44, 46 and 51-54.**

2. Even if the amendment were to be entered, applicants would not overcome the enablement rejection (item 4, Final rejection). Applicants argue that the term "cellular invasion" refers to the movement of cell from a first bodily location to a second bodily location (page 1, lines 9 to page 2, line 5). According to the specification on page 1, cell motility and invasion are essential physiological processes in tissue development and homeostasis, including angiogenesis, inflammation and they are also key factors in many pathological processes such as tumor progression and metastasis. Since the

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purpose of the inhibition cellular invasion is to treat diseases such as cancers and inflammation, applicant's argument is not persuasive. Applicants are silent in rebutting the point that "inhibition of cellular invasion" are used for the treatment of cancers as set forth in the previous Office Action (item 4).

Applicants allege that "cellular invasion" refers to the movement of cell from a first bodily location to a second bodily location, but this also covers the inhibition of healthy cells from first bodily location to another. Since the claim covers inhibition of any cellular invasion (i.e. inhibition of cells from going from first bodily location to a second location) it would cause interference in the biological activities of a healthy person. Cells that are normally supposed to move from one part of the body to another different bodily part are inhibited, and this would cause harm even death in a healthy person e.g. blood. Applicants argue that they have provided working example on page 17 and results on page 23, but this working example is not representative of inhibition of cellular invasion that is recited in claim 40. Since inhibition "cellular invasion" covers inhibition of cancers, inflammation and inhibition of normal cells from one bodily part to the other (according to applicant's definition of cellular invasion), the rejection would have been maintained even if the amendment were to be entered.

The same is true for angiogenesis.

In regard to the second paragraph rejection "cellular invasion", applicants argue that cellular invasion is invasion by a cell of other parts of a body, and not invasion of an agent into a cell. Please refer to the response of the previous Office Action (item 5b, Final Rejection) for details. Applicants also argue that "cellular invasion" refers to the

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movement of cell from a first bodily location to a second bodily location (Page 1, lines 9 to page 2 line 5), but said lines in the specification does not refer "cellular invasion" as a movement of cell from a first bodily location to a second bodily location. No such actual language appears in the specification.

The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

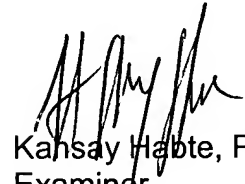
### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kamsay Habte, Ph. D.  
Examiner  
Art Unit 1624



Mark L. Berch  
Primary Examiner  
Art Unit 1624

KH  
January 24, 2005